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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,773	12/20/2001	Noriaki Ogishima	217573US2	6918
22850	7590	12/01/2006	EXAMINER	
C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			HEWITT II, CALVIN L	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,773

Applicant(s)

OGISHIMA, NORIAKI

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-7, 9-36, 38 and 39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-7, 9-36, 38 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Status of Claims

1. Claims 1, 2, 4-7, 9-36, 38 and 39 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 2, 4-7, 9-36, 38 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites updating “a version of the program used by the image forming apparatus based on the deciphered data” wherein the deciphered data is also printed on a recording medium. According to Applicant's Specification deciphered data refers to “content” such as copyright protected, editable data (Specification, page 4, lines 6-17) and deciphered data is used for printing *or* updating (Specification, page/line 21/24-22/10), and not both. Therefore, to one of ordinary skill the operation of Applicant's apparatus is unclear (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)). Claims 6, 11, 18, 25, and 29 recite similar limitations.

Claims 2, 4, 5, 7, 9, 10, 12-17, 19-24, 26-28, 30-36, 38, and 39 are also rejected as each depends from either claim 1, 6, 11, 18, 25 or 29.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 6, 7, 15, 22, 25-27, 29-31, 35, 38, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 6,233,684 in view of Schneck et al., U.S. Patent No. 5,933,498 and Perlman, U.S. Patent No. 6,363,480.

As per claims 1, 2, 6, 7, 9, 15, 22, 25-27, 29-31, 33-35, 38, and 39, Stefik et al. teach an image forming apparatus comprising:

- a key sending part to an external apparatus (column 14, lines 57-61)
- deciphering part for deciphering enciphered data received from an external apparatus (column/line 14/63-15/13)

- a judging part to determine whether deciphered data is valid (i.e. user has view or play “right” and not “print” right) printing part to print valid data (figures 6, 7 and 15; column 9, lines 3-10, 28-40, and 55-60; column 18, lines 55-59)
- receiving enciphered data from an external apparatus (column/line 14/65-15/3)
- request generating at terminal equipment to request data from an external apparatus or server, wherein the data is to be enciphered by the transmitted enciphering key (column/line 14/65-15/3)
- accounting processing with respect to enciphered data (column 15, lines 54-65)

Stefik et al. teach viewing and selecting a digital work over the internet using a browser. The Examiner takes Official Notice that thumbnails and summaries in hypertext are well-known computer programs for allowing an internet user to select internet content. Stefik et al. also teach online accounting where an external apparatus is notified of the actions performed on the user end (column 15, lines 56-65), hence it would have been obvious to one of ordinary skill to configure the system of Stefik et al. to track how user interacts with content (column 9, lines 28-62). Stefik et al. do not specifically disclose notifying an

external apparatus if actions are not valid and updating software using deciphered data. Schneck et al. teach updating software if deciphered data is valid (i.e. user has rights) (column/line 23/5-24/4; column 25, lines 10-40) and the data includes data for updating the software (column 29, lines 58-63). Schneck et al. also teach determining whether deciphered data is valid (column 20, lines 16-25), distributing rights and content over a network for payment (figures 1 and 5), distributing rights separate from its associated content (column 13, lines 45-50; column 14, lines 26-31; column 22, lines 51-54) and requiring a user to obtain a new license or additional rights for utilizing content (column 24, lines 5-24). Therefore, the prior art at least suggests a notifying part for electronically purchasing additional rights for obtained content (e.g. claim 34). Stefik et al. disclose a method for securing content using a combined symmetric and asymmetric system, while Schneck et al. use both public and secret key cryptography (column 12, lines 16-48). Specifically, Stefik et al. teach enciphering content with a symmetric or secret key (e.g. DES), enciphering the secret key with a user public key and transmitting the enciphered key and content to the user. However, Stefik et al. is silent regarding the source of the secret key (column/line 14/57-15/5). Perlman teaches a suitable system for generating secret keys. The Perlman system operates as follows: a sending party who desires to securely transmit data to a receiving party requests a secret

key from said receiving party, the receiving party generates the key and transmits the key to the sending party, who in turn enciphers the data with the key and transmits the enciphered data to the receiving party (abstract; column 3, lines 10-17; column 6, lines 4-11). Since the key is symmetric, the receiving party retains the key (copy or original) in order to decipher the enciphered data. Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Stefik et al., Schneck et al. and Perlman in order to ensure limited access to content ('480, column 6, lines 13-17; '684, column 5, lines 55-59; '498, column/line 23/5-24/4; column 25, lines 10-40).

6. Claims 4, 5, 9, 10, 16, 17, 23, 24, 28, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 6,233,684, Schneck et al., U.S. Patent No. 5,933,498 and Perlman, U.S. Patent No. 6,363,480 and as applied to claims 1, 6, 15, and 22, and in further view of Chou et al., U.S. Patent No. 5,337,357.

As per claims 4, 5, 9, 10, 16, 17, 23, 24, 28, and 32, Stefik et al. teach a secure content distribution system where content is enciphered and access is determined by creator rights (figures 6, 7, and 15). Schneck et al. teach updating software if deciphered data is valid (i.e. user has rights) (column/line 23/5-24/4; column 25, lines 10-40) and the data includes data for updating the software (column 29, lines 58-63). Perlman teaches encipher key generation and

distribution where keys have limited terms (abstract; column 6, lines 13-17).

However, neither Stefik et al., Schneck et al. nor Perlman, specifically disclose generating an encrypting key using a random variable unique to user device.

Chou et al. teach a method for generating an encryption key that is unique to the receiving apparatus using a obvious to one of ordinary skill to combine the teachings of Stefik et al., Schneck et al., Perlman and Chou et al. in order to prevent a content receiving party from making content accessible to other unauthorized parties ('357, column/line 2/40-3/13).

7. Claims 11-14 and 18-21 re rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 6,233,684 and Schneck et al., U.S. Patent No. 5,933,498.

As per claims 11-14 and 18-21, Stefik et al. teach an image forming apparatus comprising:

- requesting data from a server (column 14, lines 40-51)
- enciphering requested data and transmitting said enciphered data over a network (column/line 14/65-15/5)
- receiving and deciphering enciphered data with a printing function (column 15, lines 5-25)
- determining whether deciphered data is valid and printing valid deciphered data (i.e. user has view or play "right" and not "print")

right) (figures 6, 7 and 15; column 9, lines 3-10, 28-40, and 55-60; column 18, lines 55-59)

- request generating at terminal equipment to request data from an external apparatus or server, wherein the data is to be enciphered by the transmitted enciphering key (column/line 14/65-15/3)

However, Stefik et al. does not specifically disclose notifying an external apparatus if actions are not valid. Schneck et al. teach updating software if deciphered data is valid (i.e. user has rights) (column/line 23/5-24/4; column 25, lines 10-40) and the data includes data for updating the software (column 29, lines 58-63). Schneck et al. also teach determining whether deciphered data is valid (column 20, lines 16-25), distributing rights and content over a network for payment (figures 1 and 5), distributing rights separate from its associated content (column 13, lines 45-50; column 14, lines 26-31; column 22, lines 51-54) and requiring a user to obtain a new license or additional rights for utilizing content (column 24, lines 5-24). Therefore, the prior art at least suggests a notifying part for electronically purchasing additional rights for obtained content (e.g. claim 34), and it would have been obvious to one of ordinary skill to combine the teachings of Stefik et al. and Schneck et al. in order to allow users to more efficiently obtain software updates ('498, column 29, lines 58-63).

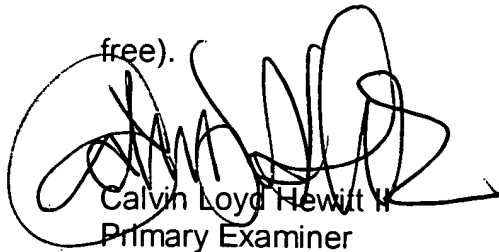
Conclusion

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).



Calvin Loyd Hewitt II
Primary Examiner

November 25, 2006